

Attorney's Docket: 1751
Serial No.: 10/049,219
Group: 1751

REMARKS

The Office Action mailed November 3, 2004, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

The claims pending in this Application are 18-26, 29, and 37-39. By this Amendment, Applicants have amended Claims 18, 20, and 23-26. Without prejudice to filing a divisional, Claims 21-22, 29 and 37-39 have been canceled as being directed to a nonelected invention. Consequently, the claims under consideration are believed to include claims 18-20 and 23-26.

Claim Rejection Under 35 USC § 112 Second Paragraph

Claim 20 stands rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office finds the phrase, "...a polyester made from the compounds as described above..." indefinite due to the limitation not making the invention clear or defining the boundaries of the invention as claimed. Applicants have amended Claim 20 to more particularly point out and distinctly claim the invention. Specifically, Claim 20 now claims the production steps of the polyester by esterification or transesterification. In view of this amendment it is believed that the § 112, second paragraph rejection has been overcome.

Attorney's Docket: 1751
Serial No.: 10/049,219
Group: 1751

Claim Rejections Under 35 USC § 102(b) or in the Alternative, Under 35 USC § 103(a)

Claims 18-21 stand rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being unpatentable over Joyner et al. (US 4,483,969) for the reasons cited in previous Office Actions. This rejection is respectfully overcome.

Applicants' invention, as defined by the amended claims, is directed to a method for treatment of a textile piece good that includes adding a polyester to an aqueous liquor along with a thickening agent. Joyner et al. (US 4,483,969) neither discloses nor teaches such a combination.

A rejection under § 102 requires the prior art reference to disclose each and every element of a claimed invention. As Joyner et al. do not disclose a combination of monofunctional end capped polyesters and a thickening agent, it is respectfully contended that Applicants' invention is not anticipated thereby.

With respect to § 103, a *prima facie* case of obviousness requires the prior art to provide some motivation for one with ordinary skill in the art to arrive at the claimed invention. Here, Joyner fails to provide the required motivation, as there is nothing within Joyner that would motivate one with ordinary skill in the art to add the thickening agent with the monofunctional end capped polyesters as is claimed. As the prior art does not contain the motivation necessary to establish a *prima facie* case, Applicants contend, respectfully, that Joyner does not make claims 18-20 obvious under 35 USC § 103.

Claim 21 has been canceled by this Amendment and consequently Applicants respectfully request this rejection be withdrawn.

Claims 18-26 stand rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being unpatentable over Miracle et al. (US 5,576,282). This rejection is respectfully overcome.

Attorney's Docket: 1751
Serial No.: 10/049,219
Group: 1751

As argued above in regards to Joyner et al. (US 4,483,969), a rejection under § 102 requires the prior art reference to disclose each and every element of a claimed invention, and, as Miracle et al. (US 5,576,282) does not disclose a combination of monofunctional end capped polyesters and a thickening agent, it is respectfully contended that Applicants' invention is not anticipated thereby.

With respect to § 103, a *prima facie* case of obviousness requires the prior art to provide some motivation for one with ordinary skill in the art to arrive at the claimed invention. Here, Miracle et al. fails to provide the required motivation, as there is nothing within Miracle et al. that would motivate one with ordinary skill in the art to add the thickening agents with the monofunctional end capped polyesters as claimed by the Applicants. As the prior art does not contain the motivation necessary to establish a *prima facie* case, Applicants contend, respectfully, that Miracle et al. does not make claims 18-26 obvious under 35 USC § 103.

Claims 21-22 have been canceled by this Amendment and thus Applicants respectfully request this rejection be withdrawn.

In view of the foregoing, Applicants respectfully seek reconsideration and withdrawal of the § 102 and 103 rejections.

Claim Objections

Claims 18 and 20 are objected to for informalities. The Office states there is no support in claim 18 for: "...wherein the molar ratio of the adducts...". Claim 18 has been amended to clarify the molar ratio recited is the molar ratio of the ethylene oxide to the combination of propylene glycol and polyethylene glycol. (Please see page 16, paragraph 31 of the specification). Claim 20 is objected to due to its dependency on claim 18. In view of these amendments, Applicants believe the objection and to Claims 18 and 20 has been overcome.

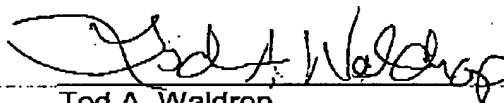
As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However, if an additional fee is required, the

Attorney's Docket: 1751
Serial No.: 10/049,219
Group: 1751

Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, she is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,



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